

REMARKS

The Official Action of 8 September 2005 has been carefully considered and reconsideration of the application as amended is respectfully requested.

Claim 1 has been amended to remove the basis for the rejection under 35 USC 112, second paragraph appearing at paragraph 4 of the Official Action. The amendment does not change the scope of the claim, but simply makes clear what was inherent in the application as filed, namely that the Ra values according to JIS B0601 described in the specification have a unit of “ μm ”. In this connection, those of skill in the art would recognize that the unit is generally not shown in expressing Ra values (see, for example, English translation of Kamikubo (JP 2003-211841)). Those of skill in the art would also recognize from the specification as filed at, for example, page 10, last paragraph, and the Examples beginning on page 27, that the unit must be “ μm ” as the described effects and experimental results would only be reproducible when Ra is measured in this unit.

New claims 10-18 have been added more completely to define the subject matter which Applicants describe as their invention. Support for the recitations in these claims appears in the specification as filed at, for example, page 18, lines 11-16; page 16, lines 10-16; page 19, lines 1-3 and 10-13; and page 20, lines 16-18. The recitations in the method claims track the recitations in original claim 7. All claims now of record are respectfully believed to be sufficiently definite to satisfy the dictates of 35 USC 112, second paragraph.

The claims were rejected under 35 USC 103(a) as allegedly being unpatentable over Kamikubo. Applicants respectfully traverse this rejection.

First, Applicants respectfully note that Kamikubo has a publication date of July 30, 2003, which is **after** the filing date of Applicants' Japanese priority application JP 2003-146586, filed May 23, 2003. Accordingly, the reference is not citable against any of the present claims that draw 35 USC 112 support from the disclosure in the priority application (see MPEP Section 201.15). Applicants submit herewith an English translation of their priority application to overcome the rejection with respect to claims 1-4 and 7-9, which are supported in the priority application under the provisions of 35 USC 112, first paragraph.

With respect to claims 5 and 6, Applicants respectfully note that the claimed invention is based at least in part on Applicants' discovery that: (a) by maintaining the Ra of the protective layer-laminating surface in the range of about 0.2 to 0.5, it is possible to impart a good matte tone to the image surface while maintaining a desirable reflection density of the image; and (b) the inclusion of a high Tg emulsion and/or inorganic particles/wax in the claimed protective layer provides additional advantages over protective layers in which they are not included. This is shown, by way of example, in the Examples described in the specification beginning on page 27, as next discussed.

In the Examples, each of Examples 1-5 comprises an image protecting film on a support having an Ra within the claimed range whereas Comparative Examples 1 and 2 have supports

wherein the Ra is above (Comparative Example 2) or below (Comparative Example 1) the claimed range (see Table 1 on page 33 of the specification). The image protecting film of Examples 1-3 contain both a high Tg emulsion and silica/wax whereas the image protecting film of Example 4 contains the former but does not contain the latter, and the image protecting film of Example 5 does not contain the former but does contain the latter (see Table 1).

As shown in Table 2 on page 42 of the specification, each of Examples 1-5 performed better than Comparative Example 1 in the evaluation for “Matte Feeling” and each performed better than Comparative Example 2 in the evaluation for “Transferability” and “Color Developability”. (The evaluation criteria are described in the specification at pages 34-41.) Examples 1-3, containing both the high Tg emulsion and the silica/wax, performed better than Examples 4 and 5, containing only either the high Tg emulsion or the silica/wax, in a number of evaluations, including “Transferability”, “Cuttability of Edges”, “Blocking Resistance”, “Scratch Resistance” and “Storage Stability in Album” (see Table 2).

The results described in the specification show the criticality of the surface roughness of the support and the advantages of the inclusion in the claimed image protecting film of either a high Tg emulsion, a silica/wax or, preferably, both. In contrast, the cited reference describes only the addition of a slipping property-imparting agent (paragraph [0017]) or organic or inorganic filler (paragraphs [0021] and [0026]) to the protective layer. However, the reference does not show or suggest any specific details thereof or effects provided by these optional additives, and indeed the preferred embodiments in the Examples do not contain any such agent

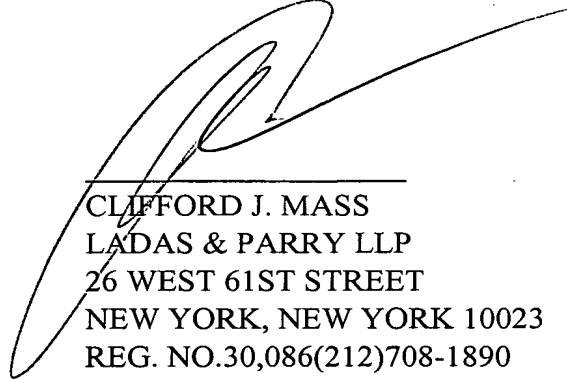
or filler (Kamikubo at [0038]-[0039]). Moreover, the reference is silent as to the use of a high Tg emulsion. Accordingly, there is nothing in the reference to show or suggest (a) that the glass transition temperatures of the recited thermoplastic resins are result-effective variables (claims 5 and 10-18), or (b) the advantageous effects provided to the claimed image protective film by a high Tg emulsion and/or silica/wax (claims 5, 6 and 10-18).

Since the reference does not show or suggest the result effective nature of the glass transition temperatures of the recited thermoplastic resins, it cannot be said that the optimization of such variables would have been obvious to one of skill in the art. See MPEP Section 2144.05(II)(B) (“A particular parameter must first be recognized as a result-effective variable, i.e., a variable which achieves a recognized result, before the determination of the optimum or workable ranges of said variable might be characterized as routine experimentation.”). Accordingly, the reference cannot set forth even a *prima facie* case of obviousness for the invention as defined in claims 5 and 10-18.

Even assuming for the sake of argument that the references could be considered to set forth a *prima facie* case of obviousness, the evidence in the specification of unexpectedly advantageous results with the claimed invention and, in particular, the high Tg emulsion and/or silica/wax recited in each of claims 5,6 and 10-18, would be sufficient to rebut the alleged *prima facie* case (see discussion above). Accordingly, it is respectfully submitted that the prior art rejection of record has been overcome with respect to all claims and should be withdrawn.

In view of the above, it is respectfully submitted that all rejections and objections of record have been overcome and that the application is now in allowable form. An early notice of allowance is earnestly solicited and is believed to be fully warranted.

Respectfully submitted,



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